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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,044	10/23/2003	Neil Cheyne	1170/39383A	6435

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EXAMINER
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PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/692,044

Applicant(s)

CHEYNE, NEIL

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/856,412.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031023;20040730</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 3-4, in the reply filed on 14 January 2005 is acknowledged. The traversal is on the ground(s) that "[t]he claims of Group I are closely related to the claims of Group II and are directed toward the same invention." This is not found persuasive because Group II is directed to "a direct current power supply for a washing appliance". In response to applicant's arguments, the recitation "for a washing machine" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, as clearly recited in the Restriction Requirement, the direct current power supply of Group II could be used to practice another and materially different process such as a process for operating various electrical machines such as dishwashers, air conditioners, or phone chargers. Thus, the search for the broad direct current power supply of Group II is not required for the specific method of Group I.
2. Applicant's recitation of general case law regarding restriction practice has been considered but is not persuasive because applicant has not provided any appropriate

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showings or evidence regarding the specifics of the instant restricted Groups I & II.

Applicant is reminded of MPEP §803, which states:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

3. Since applicant has failed to provide any appropriate showings or evidence, and since a serious burden for searching both Groups has been clearly established, the requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-2 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 14 January 2005.

### ***Specification***

5. The disclosure is objected to because of the following informalities: On page 3, lines 20-24 & page 8, line 5, it appears applicant is attempting to disclose essential material relative to the instant invention (see "Australian Patent 651408" on pages 3 & 8). However, this appears to be a typographical error since AU 651408 is directed to "Alcoholic marking ink composition" and does not appear to be applicant's patent. In view of applicant's foreign priority document, NZ 332836, it appears the disclosure is directed to New Zealand Patent 236551. Clarification and correction are required.

6. On page 5, lines 24-26 & page 8, line 5, it appears applicant is attempting to incorporate by reference essential material from a foreign patent. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

7. The title of the invention is not descriptive of the claimed invention. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 3-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,604,387 to CHEYNE. CHEYNE discloses a direct current power supply with a switch mode power supply, switching devices a circuit connected to user controller (push button switch) for switch a load on and off, and a capacitor (see Figures

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1, 2, 6 and relative associated text). The direct current power supply of CHEYNE reads on applicant's claimed invention.

### ***Conclusion***

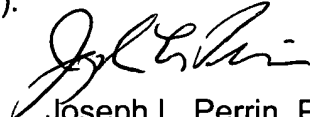
10. It is noted that multiple "X" references were cited in the International search report for parent PCT/NZ99/00193. However, the references are not deemed necessary as prior art rejections since the references were only applied to claims 1-6 (claims directed to parent U.S. Patent No. 6,748,618) and not the claims of the instant application.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joseph L. Perrin, Ph.D.  
Examiner  
Art Unit 1746

jlp